

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

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15 OCT 2004

Applicant's or agent's file reference TAB/60239/001		FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)		WIPO PCT
International application No. PCT/GB 03/02723	International filing date (day/month/year) 25.06.2003	Priority date (day/month/year) 25.06.2002		
International Patent Classification (IPC) or both national classification and IPC D21H21/48				
Applicant DE LA RUE INTERNATIONAL LIMITED				

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.
 - ☒ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 1 sheets.

3. This report contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application

Date of submission of the demand 21.10.2003	Date of completion of this report 14.10.2004
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Naeslund, P Telephone No. +49 89 2399-8614



**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/GB 03/02723

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17))*):

Description, Pages

1-11 as originally filed

Claims, Numbers

9 (part), 10-21 as originally filed

1-8, 9 (part) received on 30.08.2004 with letter of 30.08.2004

Drawings, Sheets

1/5-5/5 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

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5. ☒ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

see separate sheet

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	5-9,13-16,18
	No: Claims	1-4,10-12,17,19-21
Inventive step (IS)	Yes: Claims	NONE
	No: Claims	1-21
Industrial applicability (IA)	Yes: Claims	1-21
	No: Claims	NONE

2. Citations and explanations

see separate sheet

Re Item I

Basis of the report

It is considered that the application comprises added subject-matter contrary to Article 34(2)(b) PCT & Rule 70.2(c) PCT. The wording introduced into claim 1, i.e. "a gap being formed between the elongate element and a perimeter of the aperture" is nowhere to be found in the application documents as originally filed, let alone a definition as to what is to be understood by "a perimeter of the aperture".

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

- D1: EP-A-1 114 893 (TOKUSHU PAPER MFG CO LTD) 11 July 2001 (2001-07-11)
- D2: US-A-5 961 432 (MURAKAMI TORU ET AL) 5 October 1999 (1999-10-05)
- D3: US-A-5 573 639 (SCHMITZ CHRISTIAN ET AL) 12 November 1996 (1996-11-12)
- D4: GB-A-1 604 463 (BANK OF ENGLAND) 9 December 1981 (1981-12-09)

1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1-4,10-12,17,19-21 is not new in the sense of Article 33(2) PCT.

The document D1 (see para. 0002, 0017 and 0024; fig. 4 and 7) discloses (the references in parentheses applying to this document):

a substrate (1) having an elongate element (T) partially embedded therein and at least one discrete aperture (W) extending through the fibrous substrate exposing at least a part of the elongate element, wherein at least one edge of the elongate element is exposed in the aperture(s) (see in particular fig. 7 and compare with present application figs. 14 and 15).

Thus claim 1 is not novel. Similar arguments applies to independent claims 10 and 17 and in view of D2 (see abstract; fig. 1,2; col. 5, line 17-line 28), D3 (see col. 4, line 7-line 54; fig. 7) and D4 (see page 2, line 75-line 92; page 3, line 51-82; figs 3 and 4). This finding is extended to dependent claims 2-4,11 and 12 in view of these documents.

Note that, in view of the fact that the feature "the fibrous substrate" lacks an antecedent in the claims, the independent claims 1, 10 and 17 do not make clear that the aperture extends through the whole substrate. Moreover, from fig. 4 of D4 it is fully clear that this document discloses an aperture which extends through the whole fibrous substrate.

As to claims 19-21 they are unclear (Art. 6 PCT) to such a point that they are, for obvious reasons (they do not comprise any technical features whatsoever) novelty destroyed by each of the cited prior art documents; Art. 33(2) PCT.

Moreover, Rule 6.2a PCT explicitly makes clear that claims shall not rely on references to the figures.

2. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 5-9, 13-16 and 18 does not involve an inventive step in the sense of Article 33(3) PCT.

The document D1 (see cited parts) (or any of D1-D4) is regarded as being the closest prior art to the subject-matter of these claims and discloses in essence a substrate having an elongate element, a document made from such a fibrous substrate and a method for production of it. In view of the remaining documents cited, if necessary supplemented with common knowledge in the field, the skilled person arrives at the claimed subject-matter without applying any inventive skill; the feature combinations claimed would not amount to more than a juxtaposition of known measures. In any case no surprising effects could be seen directly derivable from the application of these features; Art. 33(3) PCT. (As to the added feature-see Item I above- of "a gap being formed between the elongate element and a perimeter of the aperture", as far as understood would only appear an obvious design option open to the skilled person.)

3. For the assessment of the present claims on the question whether they are industrially applicable, no particular reasoning would appear necessary to give. The industrial application would appear to be evident (Art. 33(4) PCT).

CLAIMS:-

1. A substrate having an elongate element partially embedded therein and at least one discrete aperture extending through the fibrous substrate exposing at least a part of the elongate element, wherein at least one edge of the elongate element is exposed in the aperture(s), a gap being formed between the elongate element and a perimeter of the aperture.

2. A substrate as claimed in claim 1 in which the elongate element bears indicia, images or information.

3. A substrate as claimed in claim 1 or claim 2 in which the elongate element is wholly or partially metallised.

4. A substrate as claimed in any one of the preceding claims in which the elongate element bears one or more holographic images.

5. A substrate as claimed in any one of the preceding claims in which of the elongate element has at least one colourshift areas.

6. A substrate as claimed in any one of the preceding claims in which the elongate element has at least one security embossing.

7. A substrate as claimed in any one of the preceding claims in which the elongate element is printed on one or both sides.

8. A substrate as claimed in any one of the preceding claims in which the elongate element bears a liquid crystal material.

9. A substrate as claimed in any one of the